

U.S. Patent Application No. 09/620,484
Attorney's Docket No. 99-317

REMARKS

This amendment is responsive to the final Office Action dated May 13, 2004 and to the Advisory Action of August 16, 2004. Claims 1-2, 4-8, 10-20, 25, and 27-37 were presented for examination. All claims were rejected. Claims 6 and 12 are hereby canceled without prejudice or disclaimer. Thus claims 1-2, 4-5, 7-8, 10-11, 13-20, 25 and 27-37, remain pending. Claims 1, 7, 13, 14, 17, 20, 25, 27, and 30 are independent claims. All independent claims and dependent claims 15, 34-35 are currently amended, at least for purposes of improving form. Support for these amendments is found in the application as filed, for example, in Fig. 7, blocks 710, 715 and 720 therein, and associated text in the specification. No new matter is added. Also, the specification has been amended to correct for minor typographical and clerical errors; no new matter is added thereby.

In the final Office Action, dated May 13, 2004, the Examiner applies a new reference, U.S. Patent Number 6,275,490 (hereinafter "MATTAWAY") against Applicant's claims. More specifically claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, 27, 30, and 33-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by MATTAWAY. Claims 6, 12, and 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of previously cited U.S. Patent Number 6,324,264 (hereinafter WIENER). And, claims 28, 29, 31, 32, 36, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MATTAWAY. Applicant respectfully traverses the rejection of these claims for the following reasons.

35 U.S.C. § 102(e) Rejection:

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Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 25, 27, 30, and 33-35 are rejected under 35 U.S.C. § 102(e) as being anticipated by MATTAWAY. For example, consider amended independent claim 1 which recites a combination of features. It has been amended to include at least the limitations of claim 6, namely: "receiving a calling party telephone number; storing the calling party telephone number in memory within the computer...". In the final Office Action, page 4, the Examiner states: "Regarding claims 6 and 12, referring to claims 1 and 7, Mattaway does not expressly disclose receiving, prior to signaling, the calling party telephone number; and storing the calling party telephone number." Thus, the Examiner admits that these limitations do not exist in MATTAWAY and Applicant agrees. Referring to MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051 1053 (Fed. Cir. 1987)." Accordingly, since at least certain claim elements in amended claim 1 are not found in MATTAWAY, the rejection of claim 1 under 35 U.S.C. § 102(e) must be withdrawn. Likewise, amended independent claims 7, 13, 25, 27, and 30 each contain limitations that are identical or similar to those which have been added to claim 1. Accordingly the 35 U.S.C. § 102(e) rejection of these claims must also be withdrawn. Each of dependent claims 2, 4, 5, 8, 10, 11, 33, 34, 35 depends from one of the independent claims and, at least because of their dependencies, the 35 U.S.C. § 102(e) rejection of these dependent claims should be withdrawn. Therefore, all of these claims, both independent and dependent, should be found allowable over MATTAWAY. They are also allowable over

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MATTAWAY and WIENER either taken alone or in any reasonable combination for the following reasons.

35 U.S.C. § 103(a) Rejection:

Claims 6, 12, and 14-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over MATTAWAY in view of WIENER (previously cited); claims 28, 29, 31, 32, 36, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MATTAWAY. In paragraph 14 of the final Office Action, pages 4-5, where the Examiner admits that MATTAWAY does not disclose certain subject matter discussed above, the Examiner alleges that WIENER "teaches, in a system for establishing a communications call, receiving prior to signaling, the calling party telephone number; and storing the calling party telephone number in order to correctly charge the user (Fig. 6; col. 3, line 52-col. 4, line10; and col. 5, lines 13-38)." However, any receiving of the calling party number and storing of the calling party number as may be discussed in WIENER are handled in a vastly different manner from that now claimed by Applicant. In these sections of WIENER, reference is made to "directory service 14". For example:

"Once the B party [called party] has been selected by the interactive device 16, a connection message is sent via the messaging network 12 to the directory service 14. The connection message, which includes identifying information concerning the B party, is used to access a telecommunications address for the B party and a telecommunications address also for the A party [calling party] for a telecommunications call." (WIENER, col. 3, lines 53-58, emphasis added)

Thus, after the B party (the called party) has been selected, a message is sent to a directory service to obtain addresses for the calling and called parties. Where is this service relative to the user? It is located remotely and is accessible via a messaging network such as the Internet. This is clear from directory service 14 and Internet 12 as shown in WIENER'S Fig. 1. Continuing:

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“The system 2 includes a directory service 14 which is accessible via the messaging network 12 and provides directory information, such as the telecommunications address *or number* for a party 4 or 6 [called or calling parties] which can be connected by the telecommunications network 10. (Column 3, lines 29-34, emphasis added).

Thus, the number (phone number) for the calling or called party is available via an Internet access to a remote database in a remote directory. This is not the subject matter of Applicant's claims. Each of Applicant's independent claims now recites, *inter-alia*, “storing the calling party telephone number in memory within the computer” or a system-equivalent thereof. This is drastically different from the disclosure of WIENER. Applicant shows computer 105 in its Figs. 1 and 2 and it is located where the user (calling party) is located –proximate the user interface. In the computer shown in Applicant's Fig. 2, ROM 225 is the location (the memory within the computer) in which the calling party's phone number is stored. See Applicant's specification, page 12, lines 6-7, for example. This arrangement provides substantial advantage for a user as compared to that relying upon a remote directory database. These advantages include improved economy and improved efficiency of resources, thereby avoiding the difficulties of maintaining a large remote directory and the difficulties resulting from needless traffic over the Internet to and from that remote location. WIENER'S remote directory teaches away from Applicants' claimed subject matter.

To establish a prima facie case of obviousness, all of three basic criteria must be met: first, the prior art references, when combined, must teach or suggest *all* the claim limitations; second there must be a reasonable expectation of success; and finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (See MPEP § 2143). If any one of these criteria is not met the prima facie case of obviousness is not established. In this instance, the prior art references, when combined, do not teach or suggest all of the claim limitations. Each and every amended independent claim includes the limitation of "storing the calling party telephone number *in memory within the computer*" or its system equivalent, and clearly this is not disclosed or suggested in WIENER which, quite differently, uses a remote database accessible over the Internet. A remote directory database, accessible by a computer user over the Internet, simply does not suggest local memory within the computer at the user location. Moreover, this is not shown or suggested in MATTAWAY per the final Office Action, page 4. Accordingly, a prima facie case of obviousness has not be established with respect to any and all of the independent claims including those rejected under 35 U.S.C. § 103(a). The other two criteria to establish a prima facie case of obviousness need not be considered since they are moot in view of the failure of the cited references to disclose or suggest *all* claim elements. In view of the above, the 35 U.S.C § 103(a) rejection of independent claims 14, 17, and 20 should be withdrawn and the claims found allowable. The 35 U.S.C § 103(a) rejection of dependent claims 15, 16, 18, 19 should likewise be withdrawn and the claims found allowable, as these claims depend from one of these independent claims.

The rejection of the remaining dependent claims rejected under 35 U.S.C § 103(a), namely claims 28, 29, 31, 32, 36, and 37, which depend directly or indirectly from independent

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claims 27 or 30 should likewise be withdrawn and the claims found allowable on the basis of their dependencies from allowable independent claims.

Moreover, in the advisory action, page 2, the Examiner states: "If Applicant wishes for the limitations of canceled claims 6 and 12 to be the patentable feature of the invention, Examiner urges Applicant to amend the claims to further distinguish the claims over the cited prior art. For instance, Applicant could amend the claims to include a limitation specifying that the calling party telephone number is stored in the memory of the computer only once where the stored calling party telephone number is used each time a call is attempted." Although Applicant does not subscribe to the Examiner's characterization of "the patentable feature" in the claims which recite a combination of features, where the *combination* is patentable, and although Applicant does not agree with the position taken in the Advisory Action with respect to "storing the calling party telephone number in memory within the computer", Applicant nevertheless adopts the suggestion offered by the Examiner for purposes of advancing the prosecution of this application. Namely, Applicant has amended all independent claims by adding the limitation: "*using the stored calling party telephone number to connect all calls from the calling party, subsequent to attempting the call, to any telephone number including the selected telephone number*", or its system or computer readable medium equivalent, to all independent claims. Thus, after the calling party telephone number is stored, the stored number is used in any future calls from that calling party. This is shown in Fig. 7. As the Examiner states, this additional limitation further distinguishes the claims over the cited prior art, and Applicant respectfully submits that the subject matter of the amended claims, particularly after including this limitation,

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is not disclosed or suggested in either MATTAWAY or WIENER. For this additional reason, all claims are urged to be allowable over these references taken alone or in any reasonable combination.

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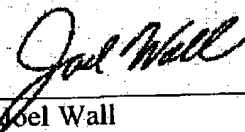
CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims. Applicant agrees with the Examiner's decision to not rely upon the other art cited and made of record. If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

By: _____



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